In The Matter Of Application No. 1907/92
By Boby Footwear Pte Ltd
To Register A Trade Mark In Class 25

And

Opposition By Parfums Nina Ricci

Before Assistant Registrar Chiam Lu Lin
16 July, 30 July and 12 Nov 1998

Trade Mark - Application for registration - Opposition - Registration under s 10 - Likelihood of confusion or deception under s 23 or s 15 - Burden of proof - Honest concurrent use - Hearsay evidence - Application allowed

The applicants, Boby Footwear Pte Ltd (the Applicants) applied for registration of the word LIZARICCI in Part A of the register in Class 25 in respect of "Boots, esparto shoes and sandals, footwear, gymnastic shoes, sandals, shoes, slippers and sports shoes". Parfums Nina Ricci (the Opponents) opposed the registration under sections 10, 11, 15 and 23 of the Trade Marks Act (Cap. 332), 1992 Rev. Ed. (the Act). The Opponents also alleged that registration of the Applicants' mark would lead to passing off.

The Opponents relied on their prior registrations of the trade mark "NINA RICCI" and other "RICCI" marks in Classes 3 & 25 . They also contended that they had long and extensive use of the mark in Singapore. The Opponents argued that in the circumstances, use of the Applicants' mark would be likely to deceive or cause confusion and the Applicants' mark was not distinctive of the Applicants' goods.

The Applicants argued that their mark was phonetically and visually distinct from the Opponents' mark and had not and would not cause deception or confusion. The word "RICCI" was commonly found in Class 25 and was not distinctive of the Opponents' alone. The Applicants chose their mark honestly, had been using their mark continuously since 1984 and claimed honest concurrent use under s 25 of the Act.

Held, allowing the application for registration:

- The word "RICCI" is a surname. The 2 marks were visually distinguishable. If pronounced in a normal way, NINA and LIZA sounded as 2 distinctly different female names. If pronounced very quickly and carelessly, there was, if at all, a remote possibility of confusion. However, the test was not mere possibility of confusion but whether there was a real tangible danger of confusion. All surrounding circumstances must be considered. People would not speak so hurriedly or carelessly when buying shoes as to lead to a real tangible danger of confusion. The purchase of shoes would be a rather measured and ponderous act in which the would-be purchaser would try on the shoes and so forth. There would be ample opportunity for the purchaser, whether he was buying for himself or someone else, to be exposed to the visual as well as the phonetic aspects of the trade marks before making a purchase. Further, besides the Opponents' and the Applicants' marks, there were other marks in Class 25 incorporating "RICCI" or a phonetic similarity to "RICCI". As "RICCI" was the common element in these marks, the purchasers would pay more attention to the other features and would distinguish them by such features. The opposition based on s 15 and 23 failed.

- The Applicants had the burden of proof of proving that trade mark applied for was not reasonably likely to deceive or cause confusion as at the date of application.

- The 3 letters tendered by the Applicants as part of their evidence were admissible as it was proposed to establish by their evidence not the truth of their statements but the fact that they were made.

- As the mark for which registration was applied for satisfied the conditions of s 10 of the Act, it qualified for registration under that section. The possibility of confusion arising from a normal and fair use of the Opponents' and Applicants' marks were properly to be considered under s 15 and 23, and not s 10.

- S 25 was an exception to the bar in s 23 against registering similar marks on the register that may cause confusion or deception. As there was no deception or confusion under s 23, the Applicants need not rely on s 25. In any case, there was evidence to support a claim of honest concurrent use.

Afternote:
[The Opponents appealed to the High Court vide Originating Motion No. 8 of 1999.The parties settled the matter before the Originating Motion could be heard and the application for trademark registration was withdrawn.]

Provisions of legislation discussed:

- Trade Marks Act (Cap. 332), 1992 Revised Edition, sections 10, 11, 15, 23 and 25.

Cases referred to:

- Bali Trade Mark (1969) RPC 472
- Smith Hayden & Co Ltd's Application (1946) 63RPC 97
- Kellogg Company v Pacific Food Products Sdn Bhd (Civil Appeal No.101 of 1998)
- Savile Row Trade Mark (1998) RPC 155
- Pianotist Co's Application (1906) 23 RPC 774
- Fitchetts Ltd v Larbet & Co Ltd (1919) 36 RPC 296
- Harrods Case (1935) 52 RPC 65
- Rose Garden Trade Mark (1995) RPC 246
- Tripcastroid Case (1925) 42 RPC 264
- Tiffany & Co. v Fabriques De Ta bac Reunies S.A. (Originating Motion No.42 of 1997)
- Alexander Pirie & Son's Ltd's application (1933) AER 956
- St Trudo Trade Mark (1995) RPC 370
- Subramaniam v PP (1956) 1 WLR 965

Representation:

- Yew Woon Chooi (Helen Yeo & Partners) for the Applicants;
- P.Sivakumar (Ella Cheong & Mirandah) for the Opponents.